

Appl. No. : 10/007,641
Filed : November 6, 2001

REMARKS

This paper amends Claims 1, 6, 9 and 12. Claims 2-5, 7-8, 10-11 and 13 are unchanged. Claims 1-13 are pending. Reconsideration and allowance of the claims is respectfully requested. Applicant has amended Claims 1, 6, 9 and 12 for clarification, and not to avoid any prior art and not to narrow the claims. Applicant has replaced the term "information" with "data" in Claims 1, 6, 9 and 12 to be consistent in the independent claims and with the dependent claims. Claim 9 has been amended to clarify the preamble.

Discussion of the Objection to the Specification

The disclosure was objected to because of the informality of an improper reference number. In response, Applicant has amended the specification on page 8 such that the description refers to Figure 2 and also Figure 1. Applicant respectfully submits that the medical database system 10 which is referred to on pages 8 and 9 therefore properly has referral to Figure 1.

Discussion of the Rejection under 35 U.S.C. § 112, ¶2

Claims 9-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, the preamble has been amended to be "a method for performing a compliance check...".

Discussion of the Rejections under 35 U.S.C. § 103(a)

Claims 1-8 and 12-13 were rejected under 35 U.S.C. 103(a) as being obvious over Clawson (U.S. Patent No. 6,106,459) in view of Barrett et al. (U.S. Patent No. 6,029,144).

Prima Facie Obviousness Requires a Teaching or Suggestion of All Claim Limitations

M.P.E.P. § 2143.03 recites that all claim limitations must be taught or suggested. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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Analysis

The Office Action states that the Clawson patent discloses a medical emergency database configured to store clinical encounter data, patient demographic data and transport data at column 3, line 65 to column 4, line 12 of Clawson. However the cited text does not discuss that any of the described items are stored in a database. It appears that any information gleaned during the call is used to provide the proper instructions to the caller and to dispatch the correct vehicle and crew. Figure 5 at state 504 and column 6, lines 56-57 of Clawson describe that "a database is accessed 504 to produce the appropriate instructions for communication with the caller". The subsequent sentence, "Records of the calls and queries are stored 505, for historical reports, for review of the dispatchers and for continued quality assurance control", seems to be the only discussion of storing. Since the preferred embodiment of the emergency medical dispatch system of Clawson is a set of flip-cards as shown in Figures 2, 3 and 7, the storage of records is a logbook entry of date, time and query for the call and is not a database.

The Office Action admits that the Clawson reference does not disclose the remaining features of Claim 1. The Barrett reference is cited by the Office Action for these features. Barrett is directed to a system for checking for fraud in employee expense accounts. However, Barrett does not describe "a compliance audit component in communication with the medical emergency database" as recited in Applicant's Claim 1. Furthermore, Clawson does not have a database storing clinical encounter data, patient demographic data and transport data, but merely contains medical instructions for particular situations (e.g., instructions for what to do if the patient is not breathing).

Prima facie Obviousness Requires a Suggestion or Motivation and an Expectation of Success

As stated in the Manual of Patent Examining Procedure 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to

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make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

When an obviousness rejection is based on multiple prior art references, there must be a showing of a teaching, suggestion, or motivation to combine the references. Although the references need not expressly teach that their disclosures should be combined, the showing of combinability must be "clear and particular". *Winner Int'l Royalty Corp. v. Wang*, 2002 F.3d 1340, 1348-1349 (Fed Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994,999 (Fed. Cir. 1999)). Motivation to combine requires desirability. *Id.*

As stated in the Manual of Patent Examining Procedure 2143.01, the fact that references can be combined or modified is not sufficient to establish prima facie obviousness. The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish prima facie obviousness.

Analysis

The Office Action does not provide the required suggestion or motivation to combine the references for the independent claims. The Office Action needs to provide an objective reason to combine the teachings of the references and to provide the source of the suggestion that one would combine a system that checks for fraud in employee expense accounts (Barrett) with an emergency medical transportation system (Clawson). The fact that references can be combined or modified, or the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish prima facie obviousness.

Thus, Applicant respectfully submits that the Examiner has not met his prima facie burden to provide an objective reason to combine the teachings of the references and to provide the

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source of the suggestion, and has not presented a convincing line of reasoning, where the showing of combinability must be "clear and particular".

Dependent Claims

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. Claims 2-8, 10-11 and 13 are dependent either directly or indirectly on the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

Conclusion

In view of the foregoing remarks, Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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